UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,545	01/18/2002	Falko Tesch	P-5714	7142

7590   03/25/2005

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EXAMINER
CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
2179	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 January 2002*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *09 April 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/15 and 5/13/02*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: Application filed on 01/18/2002,

Information Disclosure Statements filed on 05/13/2002 and 10/15/2002, and Formal

Drawings filed on 04/9/2002.

2.   Claims 1-27 are pending in the case. Claims 1, 12, 16, 17, 18, 21, 24, and 27

are independent claims.

Priority

3.   Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which

papers have been placed of record in the file.

Drawings

4.   The drawings were received on 04/09/2002. These drawings are accepted.

Claim Rejections - 35 USC § 101

5.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 18-20 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. The claims are non-statutory because the

interface in the claims is not tangibly embodied in a manner so as to be executable.

Further, a collection of cells and buttons, per se, is an abstract idea, directed solely to

non-functional descriptive material, which is also non-statutory.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

8.   Claims1-4, 9-12, 14, 15, 21, and 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Madduri (US Patent Number 6,567,830, filed on February 12,1999) in

view of Durst et al. (hereinafter Durst, "Ruby Annotation" W3C Working Draft from

December 17, 1999, included in IDS).

Regarding independent claim 1, Madduri discloses a method in which a first

base text is selected from a document and displayed in a cell, which allows this first

base text to be altered, the alteration being the text that appears in the cell (Figure 5

and 6, column 5, lines 24-67, column 6, lines 30-49 and column 6, line 66-column 7, line

12 of Madduri). Madduri also discloses that a user can add an annotation the base text

(column 6, line 66-column 7, line 12 of Madduri). Madduri does not disclose a method

in which the annotation is ruby text. However, Durst discloses that ruby text was a well-

known annotation type (pages 2-5, Section 1.1 "What is a Ruby?" of Durst). It would

have been obvious to one of ordinary skill in the art at the time the invention was made

to have combined the methods of Madduri with the teachings of Durst because it would

have provided easy to find, short annotation in the immediate vicinity of content in

publications.

Regarding dependent claim 2, Madduri discloses a method in which the

annotation text can be edited (Figure 5 and 6, column 5, lines 24-67, column 6, lines 30-

49 and column 6, line 66-column 7, line 12 of Madduri).

Regarding dependent claims 3-4, Madduri disclosed a method in which the

annotation text is added to the display of the document, which already contains the

base text (Figure 5 and 6, column 5, lines 24-67, column 6, lines 30-49 and column 6,

line 66-column 7, line 12 of Madduri).

Regarding dependent claim 9, Madduri discloses a method in which the

selection area may be adjusted around a more specific portion than originally (Figure 5

and 6, column 5, lines 24-67, column 6, lines 30-49 and column 6, line 66-column 7, line

12 of Madduri).

Regarding dependent claims 10-11, Madduri discloses a method in which the

working document is a text document comprising text (Figure 5 and 6 of Madduri).

Regarding independent claim 12, Madduri discloses a method in which a first base text is selected from a document and displayed in a cell, and a second base text may also be selected and appear in a cell (Figure 5 and 6, column 5, lines 24-67, column 6, lines 30-49 and column 6, line 66-column 7, line 12 of Madduri). Madduri also discloses that a user can add an annotation the base texts (column 6, line 66-column 7, line 12 of Madduri). Madduri does not disclose a method in which the annotation is ruby text. However, Durst discloses that ruby text was a well-known annotation type (pages 2-5, Section 1.1 "What is a Ruby?" of Durst). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Madduri with the teachings of Durst because it would have provided easy to find, short annotation in the immediate vicinity of content in publications.

Regarding dependent claim 14, Madduri disclosed a method in which the annotation text is added to the display of the document, which already contains the base text (Figure 5 and 6, column 5, lines 24-67, column 6, lines 30-49 and column 6, line 66-column 7, line 12 of Madduri).

Regarding dependent claim 15, Madduri discloses a method in which a first base text is selected from a document and displayed in a cell, and a second base text may also be selected and appear in a cell (Figure 5 and 6, column 5, lines 24-67, column 6, lines 30-49 and column 6, line 66-column 7, line 12 of Madduri). Madduri also discloses that a user can add an annotation the base texts (column 6, line 66-column 7, line 12 of Madduri). Madduri does not disclose a method in which the

annotation is ruby text. However, Durst discloses that ruby text was a well-known

annotation type (pages 2-5, Section 1.1 "What is a Ruby?" of Durst). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the methods of Madduri with the teachings of Durst because it would

have provided easy to find, short annotation in the immediate vicinity of content in

publications.

Regarding independent claim 21, the claim incorporates substantially similar

subject matter as claim 1. Thus, the claim is rejected along the same rationale as claim

1.

Regarding independent claim 24, the claim incorporates substantially similar

subject matter as claim 1. Thus, the claim is rejected along the same rationale as claim

1.

9.   Claims 5-7, 13, 16, 22-23, and 25-27 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Madduri (US Patent Number 6,567,830, filed on February

12,1999) in view of Durst et al. (hereinafter Durst, "Ruby Annotation" W3C Working

Draft from December 17, 1999, included in IDS) as applied to claims 1, 12, 21 and 24

above, and further in view of Newbold et al. (hereinafter Newbold, US Patent Number

5,576,955, issued on November 19, 1996).

Regarding dependent claims 5-7, neither Madduri nor Durst disclose a method

in which the base text cell and ruby text cell are in a separate window than the working

document. However, Newbold discloses a method in which the base text and

annotation text are interfaced with in a separate window than the document, which

causes a need for changing focus between the two windows in order to alter base text

(Figures 5A and 5B and column 6, line 25-column 7, line 15 of Newbold). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the methods of Madduri and Durst with the method of Newbold because

it would have allowed annotations to be viewed as a list and in turn handled collectively.

Regarding dependent claim 13, neither Madduri nor Durst disclose a method in

which the base text cells and ruby text cells are in a separate window than the working

document. However, Newbold discloses a method in which the base text and

annotation text are interfaced with in a separate window than the document, which

causes a need for changing focus between the two windows in order to alter base text

(Figures 5A and 5B and column 6, line 25-column 7, line 15 of Newbold). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the methods of Madduri and Durst with the method of Newbold because

it would have allowed annotations to be viewed as a list and in turn handled collectively.

Regarding dependent claim 16, Madduri discloses a method in which a first

base text is selected from a document and displayed in a cell, and a second base text

may also be selected and appear in a cell (Figure 5 and 6, column 5, lines 24-67,

column 6, lines 30-49 and column 6, line 66-column 7, line 12 of Madduri). Madduri

also discloses that a user can add an annotation the base texts (column 6, line 66-

column 7, line 12 of Madduri). Madduri does not disclose a method in which the

annotation is ruby text. However, Durst discloses that ruby text was a well-known

annotation type (pages 2-5, Section 1.1 "What is a Ruby?" of Durst). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Madduri with the teachings of Durst because it would have provided easy to find, short annotation in the immediate vicinity of content in publications. Neither Madduri nor Durst disclose a method in which the document is searched for all selected base text and all of the base text is display in cells. However, Newbold discloses a method in which all of the designated base text in a document is found and displayed in cells (Figures 5A and 5B and column 6, line 25-column 7, line 15 of Newbold). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Madduri and Durst with the method of Newbold because it would have allowed annotations to be viewed as a list and in turn handled collectively.

Regarding dependent claims 22-23, neither Madduri nor Durst disclose a method in which the base text cell and ruby text cell are in a separate window than the working document. However, Newbold discloses a method in which the base text and annotation text are interfaced with in a separate window than the document, which causes a need for changing focus between the two windows in order to alter base (Figures 5A and 5B and column 6, line 25-column 7, line 15 of Newbold). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Madduri and Durst with the method of Newbold because it would have allowed annotations to be viewed as a list and in turn handled collectively.

Regarding dependent claims 25-26, neither Madduri nor Durst disclose a method in which the base text cell and ruby text cell are in a separate window than the working document. However, Newbold discloses a method in which the base text and annotation text are interfaced with in a separate window than the document, which causes a need for changing focus between the two windows in order to alter base text (Figures 5A and 5B and column 6, line 25-column 7, line 15 of Newbold). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Madduri and Durst with the method of Newbold because it would have allowed annotations to be viewed as a list and in turn handled collectively.

Regarding independent claim 27, Madduri discloses a method in which a first base text is selected from a document and displayed in a cell, which allows this first base text to be altered, the alteration being the text that appears in the cell (Figure 5 and 6, column 5, lines 24-67, column 6, lines 30-49 and column 6, line 66-column 7, line 12 of Madduri). Madduri also discloses that a user can add an annotation the base text (column 6, line 66-column 7, line 12 of Madduri). Madduri does not disclose a method in which the annotation is ruby text. However, Durst discloses that ruby text was a well-known annotation type (pages 2-5, Section 1.1 "What is a Ruby?" of Durst). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Madduri with the teachings of Durst because it would have provided easy to find, short annotation in the immediate vicinity of content in publications. Neither Madduri nor Durst disclose a method in which the base text cell and ruby text cell are in a separate window than the working document. However,

Newbold discloses a method in which the base text and annotation text are interfaced

with in a separate window than the document, which causes a need for changing focus

between the two windows in order to alter base text (Figures 5A and 5B and column 6,

line 25-column 7, line 15 of Newbold). It would have been obvious to one of ordinary

skill in the art at the time the invention was made to have combined the methods of

Madduri and Durst with the method of Newbold because it would have allowed

annotations to be viewed as a list and in turn handled collectively.

10.   Claims 8 and 17-20 rejected under 35 U.S.C. 103(a) as being unpatentable over

Madduri (US Patent Number 6,567,830, filed on February 12,1999) in view of Durst et

al. (hereinafter Durst, "Ruby Annotation" W3C Working Draft from December 17, 1999,

included in IDS) as applied to claims 1 above, and further in view of Collins et al.

(hereinafter Collins, US Patent Number 5,594,642, issued January 14, 1997).

Regarding dependent claim 8, neither Madduri nor Durst disclose a method in

which it is determined whether or not an automatic ruby determination function is on or

off. However, Collins discloses a method in which an automatic annotation function is

used and is considered off if the program is in manual mode, on if it is in automatic

mode (column 3, line 64-column 4, line 22 and column 5, line 10-column 6, line 42 of

Collins). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have combined the methods of Madduri and Durst with the

method of Collins because it would have allowed the user the ability to choose between

the more efficient automatic mode and the more customizable manual mode.

Regarding independent claim 17, Madduri discloses a method in which a first

base text is selected from a document and displayed in a cell (Figure 5 and 6, column 5,

lines 24-67, column 6, lines 30-49 and column 6, line 66-column 7, line 12 of Madduri).

Madduri also discloses that a user can add an annotation the base text (column 6, line

66-column 7, line 12 of Madduri). Madduri does not disclose a method in which the

annotation is ruby text. However, Durst discloses that ruby text was a well-known

annotation type (pages 2-5, Section 1.1 "What is a Ruby?" of Durst). It would have

been obvious to one of ordinary skill in the art at the time the invention was made to

have combined the methods of Madduri with the teachings of Durst because it would

have provided easy to find, short annotation in the immediate vicinity of content in

publications. Neither Madduri nor Durst disclose a method in which it is determined

whether or not an automatic ruby determination function is on or off or parsing the text

into individual words. However, Collins discloses a method in which an automatic

annotation function is used and is considered off if the program is in manual mode, on if

it is in automatic mode (column 3, line 64-column 4, line 22 and column 5, line 10-

column 6, line 42 of Collins). Collins also discloses that the annotations may be found

on a word-by-word basis as the document is parsed (column 5, line 10-column 6, line 42

of Collins). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to have combined the methods of Madduri and Durst with the

method of Collins because it would have allowed the user the ability to choose between

the more efficient automatic mode and the more customizable manual mode.

Regarding independent claim 18 and dependent claims 19 and 20, Madduri

discloses a method in which a first base text is selected from a document and displayed

in a cell (Figure 5 and 6, column 5, lines 24-67, column 6, lines 30-49 and column 6, line

66-column 7, line 12 of Madduri). Madduri also discloses that a user can add an

annotation the base text (column 6, line 66-column 7, line 12 of Madduri). Madduri does

not disclose a method in which the annotation is ruby text. However, Durst discloses

that ruby text was a well-known annotation type (pages 2-5, Section 1.1 "What is a

Ruby?" of Durst). It would have been obvious to one of ordinary skill in the art at the

time the invention was made to have combined the methods of Madduri with the

teachings of Durst because it would have provided easy to find, short annotation in the

immediate vicinity of content in publications. Neither Madduri nor Durst disclose a

method in which it is determined whether or not an automatic ruby determination

function is on or off or parsing the text into individual words. However, Collins discloses

a method in which an automatic annotation function is used and is considered off if the

program is in manual mode, on if it is in automatic mode (column 3, line 64-column 4,

line 22 and column 5, line 10-column 6, line 42 of Collins). Collins also discloses that

the annotations may be found on a word-by-word basis as the document is parsed

(column 5, line 10-column 6, line 42 of Collins). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to have combined the

methods of Madduri and Durst with the method of Collins because it would have

allowed the user the ability to choose between the more efficient automatic mode and

the more customizable manual mode.

Conclusion

11.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure:

US Patent Number 5,604,897

US Patent Number 6,092,068

US Patent Number 6,424,982

US Patent Number 6,782,510

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joshua D Campbell whose telephone number is (571)

272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone

number for the organization where this application or proceeding is assigned is 703-

872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

JDC
March 17, 2005
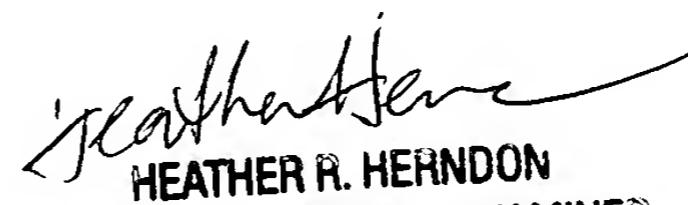
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